REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1, 2, 6, 8, 13-14 and 20 have been amended. No new matter has been added.

This amendment changes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-20 are now pending in this application.

Claim analysis

The Office Action noted that the word "state" is misspelled in claims 1 and 20. Claims 1 and 20 have been amended to correct the spelling of "state".

Rejection under 35 U.S.C. § 112, second paragraph

Claims 2, 6, 13 and 14 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Claims 2, 6, 13 and 14 have been amended to address the issues raised in the Office Action, and applicant submits that the rejection has been overcome.

Rejection under 35 U.S.C. §§ 102 and 103

Claims 1, 3-5 and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,066,391 to Faria ("Faria"). Claim 8 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,540,134 to Nelson ("Nelson"). Claims 9-12 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nelson in view of Faria. Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Nelson in view of U.S. Patent No. 5,525,225 to Janik et al. ("Janik"). Claims 17-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nelson in view of Janik, and further in view of U.S. Patent No. 5,584,987 to Mules ("Mules"). Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Faria in view of Janik. Applicant respectfully traverses these rejections for at least the following reasons.

Claim 1

Independent claim 1 is directed to an oil filter and recites "an inner tubular member disposed in the recessed portion of the cover so as to be movable into and out of the recessed portion" and "a biasing unit for urging the inner tubular member in a direction to protrude from the recessed portion of the cover." Thus, in claim 1, the inner tubular member is disposed as to be movable into and out of the recessed portion, i.e., into and out of the cover, and the inner tubular member is urged by the biasing unit in the direction to protrude from the recessed portion. The Office Action relies on Faria as disclosing these features. Applicants submit, however, that Faria neither discloses this combination of features as recited in claim 1, nor the advantages attendant thereto.

The Office Action equates elements 72, 74, 78 and 102 of Faria with the inner tubular member of claim 1, and the struts 98 with the biasing unit of claim 1. The struts 98 of Faria, however, do not function as a biasing unit to urge the assembly of elements 72, 74, 78 and 102 from any recessed portion of a cover (which the Office Action takes as elements 20, 40 and 90 of Faria). The struts 98 of Faria are provided to an end wall 90 and adapted to bear against the filter end cap 74 to hold the filter subassembly 70 in place when the oil assembly 10 is assembled (col. 5, lines 19-22). Thus, the struts 98 of Faria do not function as a biasing unit in the fashion of claim 1. Moreover, the filter assembly of Faris is of quite a different type from the oil filter of claim 1, because the filter subassembly of Faria is held in place within the cover regardless of attachment and detachment of the filter subassembly to and from the housing main body.

Moreover, Faria fails to suggest the advantages of the combination of the inner tubular member and biasing unit as recited in claim 1. This combination of features as recited enables an oil collecting space, defined by the cover, the inner tubular member, and the seal member, to increase when the inner tubular member protrudes from the cover under the bias of the biasing unit upon removal of the cover. Thus, a worker is able to discard the oil remaining inside the oil filter with ease and assuredness, without any oil being scattered to the

outside. Faria, failing to suggest the combination of the inner tubular member and biasing unit as recited in claim 1, fails to suggest the advantages attendant thereto.

Claim 8

Independent claim 8 is directed to an oil filter and recites "a partition member disposed in the recessed portion of the cover so as to be movable into and out of the recessed portion and partitioning a space between the cover and the housing main body into a filter chamber on a housing main body side and an oil suction chamber on a bottom side of the cover", "a biasing unit for urging the partition member in a direction to increase the volume of the oil suction chamber", and "a communication passage for providing communication between the oil suction chamber and the oil filter chamber." The Office Action relies on Nelson as disclosing these features. Applicant submits, however, that Nelson neither discloses this combination of features as recited in claim 8, nor the advantages attendant thereto.

The Office Action equates the diaphragm 4, spring 5, and disc tube 11 of Nelson, with the partition member, biasing unit, and communication passage, respectively, of claim 8. The chamber 3 defined by the diaphragm 4 of Nelson, however, is a vacuum chamber which communicates with the intake manifold of the engine (col. 4, lines 56-59), not a chamber that communicates with the filter chamber 19 of Nelson, which acts to filter oil. Further, the disc tube 11 of Nelson is not adapted to provide communication between the filter chamber 19 and the vacuum chamber 3. Thus, Nelson fails to suggest either the partition member or communication passage as recited in claim 8.

Moreover, Nelson fails to suggest the advantages of the combination of the partition member, biasing unit, and communication passage as recited in claim 8. In a similar fashion to claim 1, in claim 8 this combination of features of the partition member, biasing unit, and communication passage as recited, enables a worker to discard the remaining oil in the filter chamber with ease and assuredness without any oil being scattered to the outside. Moving the cover away from the housing main body for removal of the cover from the housing main

body, causes the partition member to displace under the bias of the biasing unit so as to increase the volume of the oil suction chamber. Vacuum pressure is developed in the oil suction chamber thus causing the remaining oil inside the filter chamber to be sucked into the suction chamber through the communication passage. Nelson, failing to suggest the combination of the partition member, biasing unit, and communication passage as recited in claim 8, fails to suggest the advantages attendant thereto.

Claim 20

Independent claim 20 is directed to an oil filter and recites "an inner tubular member disposed in the recessed portion of the cover so as to be movable into and out of the recessed portion" and "a biasing unit for urging the inner tubular member in a direction to protrude from the recessed portion of the cover." Thus claim 20 is patentable over Faria for reasons analogous to those discussed above with respect to claim 1.

The references of Janik and Mules fail to cure the deficiencies of Nelson and Faria.

The dependent claims ultimately depend from one of claims 1 and 8, and are patentable for at least the same reasons, as well as for further patentable features recited therein.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of

papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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